

Remarks

Claims 1, 4-32 and 40-46, inclusive, are under consideration. Applicant respectfully submits that in view of the amendments set forth above, and for the reasons discussed herein the rejections should be withdrawn and respectfully requests the same.

I. Claim rejections 35 U.S.C. §102

A. Claims 43-46 in view of Yuen et al.

Claims 43-46 are rejected as being anticipated by Yuen et al. The teaching of Yuen et al. relied upon in the Office Action relate to a table of contents. The examiner states that a table of contents is a visual content representation because it is visually displayed and shows the contents recorded. Applicant respectfully disagrees, and submits that a table of contents fairly discloses a visual content representation. The visual content of the source content is not represented by a table of contents. The clear meaning of the claim term visual content representation does not relates to a user created table of contents.

Yuen et al. provides no disclosure of an indicator wherein the visual content representation comprises a portion of the source content. Rather, a table of contents is derived by a person interpreting the source content and assigning a description of the portion of the source content. The claimed indicator is a visual content representation of a portion of the source content. As such, claim 43 as amended is clearly distinguishable over Yuen et al. Claims 44-46 depend directly or indirectly from claim 43 and accordingly are believed to be patentable for the reasons set forth above with respect to claim 43, as well as their own characterizations.

B. Claims 43-44 in view of Takahashi

Claims 43 and 44 are rejected as being anticipated by Takahashi. Applicant respectfully disagrees with the examiner's characterization of the teachings of Takahashi. Takahashi is not a video storage media control system at all. Rather, it is a editing system.

Further, the claim states that the indicator is a content-related position indicator that comprises a portion of the source content. By contrast, the cited portions of Takahashi teach that a frame number which is associated with a scene change is used as an indicator. A frame number is not related to the content of the storage medium. Instead, it is an indicator that is completely independent from the source content. In other words, a frame number bears no relationship to what is shown on a particular video frame. As such, Takahashi fails to teach all of the claimed limitations. Therefore, the rejection based on anticipation should be withdrawn.

II. Claim Rejections 35 U.S.C. §103

Pending claims 1, 4-32, and 40-42 are rejected as obvious in view of Yuen et al. in combination with Takahashi.

The claimed invention is directed to a video storage media control system including, in part, an identifying module for analyzing the contents of the video media so as to assign a content-related value to the contents that is indicative of the position of the contents on the media, with the video media position being determined by establishing a match or relationship using the content-related value. Applicant's amended claim 1 requires that the module for determining video media position and the module for identifying the contents of the video media are based on signals present or displayable on the video output terminal and that the

video media position is determined by establishing a match or relationship using displayable video contents stored on the media. Applicant's system thus requires that the video media position is determined from the video data.

As conceded in the Office Action Yuen et al. includes no such teaching. Similarly, Takahashi fails to teach such a feature. As discussed, the cited portions of Takahashi teach establishing an index based on frame numbers. Frame numbers are indicators, but they are not based on the displayable video contents stored on the media. Rather, they are separately generated indicators that are completely independent of the video content. In other words, regardless of the video content, the frame numbers are the same, and therefore, are not based on the video contents.

As such, contrary to the present invention, Takahashi fails to disclose utilizing video data content stored on the media as being the means for determining video media position. Also, Takahashi fails to teach applicant's claimed arrangement in which the video media position is determined by establishing a match or relationship using video data content stored on the media. Since the prior art fails to teach either alone or in combination each and every claimed limitation, no sustainable case of obviousness has been made. See *Ex parte Alexander*, 86 USPQ2d 1120, 1122 (Bd. Pat. App. & Int. 2007).

Furthermore, the stated reason for combining the references is insufficient. The stated basis for including the supposed teaching of Takahashi into Yuen et al. is to "facilitate the editing process." Yuen et al., however, has nothing to do with editing. Rather, Yuen et al. is a VBI decoder for operating a video tape recorder. There is simply no reason that a person of skill in the art would have sought to include supposed functionality disclosed by Takahashi

Application No. 09/601,712

that would assist in editing into Yuen et al. since Yuen et al. has nothing to do with the editing of the video content. Yuen does disclose editing of the user created titles and captions, but this is distinctly different. In order for there to be demonstration of a *prima facie* case of obviousness there must be some "rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). In this case, there is no rational reason to combine the references in the manner suggested in the Office Action. Instead, the rationale for the rejection is impermissible hindsight reconstruction of the claimed invention. *See Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966).

Accordingly, Applicant respectfully requests withdrawal of the outstanding rejections for the reasons stated above. Applicant further respectfully submits that pending claims 1, 4-32 and 40-46, all the claims now pending in the application, are now in condition for allowance and favorable action is requested.

Respectfully submitted,

Date: February 27, 2009

By: _____



Joseph M. Kuo (Reg. No. 38,943)

OLSON & CEPURITIS, LTD.
20 N. Wacker Drive
36th Floor
Chicago, Illinois 60606
(312) 580-1180

Application No. 09/601,712



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I certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 27, 2009.

A handwritten signature in black ink, appearing to read "J. M. Kuo", written over a horizontal line.

Joseph M. Kuo